

REMARKS

Applicants thank the Examiner for the consideration given the present application.

Claims 1-18 are now present in this application. Claims 1, 6, 11 and 18 are independent.

By this amendment, claims 6 and 18 are amended. No new matter is involved.

Reconsideration of this application, as amended, is respectfully requested.

Information Disclosure Statement

Applicants thank the Examiner for treating the Information Disclosure statement (IDS) filed on November 26, 2008 and for providing Applicants with an initialed copy of the Form PTO/SB/08 filed therewith.

Rejections under 35 U.S.C. §103

Claims 6, 10 and 18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Design Patent 368,965 to Nakata et al. ("Nakata") in view of JP 06-339514 to Sasaki. This rejection is respectfully traversed.

A complete discussion of the Examiner's rejection is set forth in the Office Action, and is not being repeated here.

Because the rejection is based on 35 U.S.C. §103, what is in issue in such a rejection is "the invention as a whole, "not just a few features of the claimed invention. Under 35 U.S.C. §103, " [a] patent may not be obtained . . . if the differences between the subject matter sought to be patented and the prior art are such that the subject matter *as a whole* would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said

subject matter pertains." The determination under §103 is whether the claimed invention *as a whole* would have been obvious to a person of ordinary skill in the art at the time the invention was made. *See In re O'Farrell*, 853 F.2d 894, 902, 7 USPQ2d 1673, 1680 (Fed. Cir. 1988). In determining obviousness, the invention must be considered as a whole and the claims must be considered in their entirety. *See Medtronic, Inc. v. Cardiac Pacemakers, Inc.*, 721 F.2d 1563, 1567, 220 USPQ 97, 101 (Fed. Cir. 1983).

In rejecting claims under 35 U.S.C. §103, it is incumbent on the Examiner to establish a factual basis to support the legal conclusion of obviousness. *See In re Fine*, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the Examiner is expected to make the factual determinations set forth in *Graham v John Deere Co.*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one of ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. *See Uniroyal Inc. v. F-Wiley Corp.*, 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988), *cert. denied*, 488 U.S. 825 (1988); *Ashland Oil, Inc. v Delta Resins & Refractories, Inc.*, 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), *cert. denied*, 475 U.S. 1017 (1986); *ACS Hospital Systems, Inc. v Montefiore Hospital*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the Examiner are an essential part of complying with the burden of presenting a *prima facie* case of obviousness. *See In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art

suggested the desirability of the modification. *See In re Fritch*, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783 84 (Fed. Cir. 1992). To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be suggested or taught by the prior art. *See In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1970). All words in a claim must be considered in judging the patentability of that claim against the prior art. *See In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

A suggestion, teaching, or motivation to combine the prior art references is an "essential evidentiary component of an obviousness holding." *See C.R. Bard, Inc. v. M3 Sys. Inc.*, 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998). This showing must be clear and particular, and broad conclusory statements about the teaching of multiple references, standing alone, are not "evidence." *See In re Dembiczak*, 175 F.3d 994 at 1000, 50 USPQ2d 1614 at 1617 (Fed. Cir. 1999).

Moreover, it is well settled that the Office must provide objective evidence of the basis used in a prior art rejection. A factual inquiry whether to modify a reference must be based on objective evidence of record, not merely conclusory statements of the Examiner. *See In re Lee*, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002).

Furthermore, during patent examination, the PTO bears the initial burden of presenting a *prima facie* case of unpatentability. *See In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785788 (Fed. Cir. 1984). If the PTO fails to meet this burden, then the Applicant is entitled to the patent. Only when a *prima facie* case is made, the burden shifts to the applicant to come forward to rebut such a case.

Additionally, inherency may not be established by probabilities or possibilities. What is *inherent*, must necessarily be disclosed. See *In re Oelrich*, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981); *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993).

Claim 6, as amended, recites tooth-hardening apparatus for a teething infant, comprising a plate shaped first tooth-hardening member having a first surface provided with a plurality of first projections, wherein the plate lies in a plane; and a plate shaped second tooth-hardening member having a second surface provided with a plurality of second projections; wherein the plate shaped second tooth-hardening member is arranged at a periphery of the first tooth-hardening member and is extended from the periphery of the plate shaped first tooth hardening member in the plane in which the plate shaped first tooth lies, the first surface of the first tooth-hardening member and the second surface of the second tooth-hardening member are formed of respective materials which have hardnesses different from each other, and wherein the first surface of the first tooth-hardening member is harder than the second surface of the second tooth-hardening member which is arranged at the periphery of the first tooth-hardening member, and both the first and second tooth-hardening members are adapted to be chewed by the infant.

Claim 18, as amended, recites a tooth-hardening apparatus for a teething infant, comprising: an annular plate shaped first tooth-hardening member having a top surface provided with a plurality of projections, wherein the plate lies in a plane; and oval plate shaped second tooth-hardening members having a top surface provided with a plurality of projections; wherein the oval plate shaped second tooth-hardening members are arranged at an outer peripheral edge of the annular plate shaped first tooth-hardening member at locates separated from one another and extended from the periphery of the annular plate shaped first tooth hardening member in the

plane in which the annular plate shaped first tooth lies, the top surface of the annular plate shaped first tooth-hardening member and the top surface of the oval plate shaped second tooth-hardening members are formed of respective materials which have hardnesses different from each other, the top surface of the annular plate shaped first tooth-hardening member is harder than the top surface of the oval plate shaped second tooth-hardening members, and both the first and second tooth-hardening members are adapted to be chewed by the infant.

Nakata does not disclose that its teeth correction toy is a tooth hardening device, as claimed. Nor does Nakata disclose that its teeth correction surfaces have different hardnesses. Even the Office Action admits that Nakata fails to disclose that its toy's teeth correcting member surfaces have different hardnesses.

In an attempt to remedy this deficiency, the Office Action turns to Sasaki, which differs substantially from Nakata and from the claimed invention. As disclosed in Sasaki, e.g., in paragraphs 0023 and 0028-0029 of the attached computed generated English language translation of Sasaki from the JPO Internet website, Sasaki's device has a dome part 1 with an upper surface and an undersurface formed of polycarbonate, which is a rigid resin, for containing a housed article smaller than the dome 1. Sasaki also has a number of peripheral tooth hardening parts (2), which is disclosed as being made of styrene ethylene butylene styrene (S-EB-S) which is a styrene system elastomer with elasticity (see paragraph 0024 of Sasaki).

Clearly, the only tooth hardening portions of Sasaki are the six petals 2 that are made of a single elastic material, and the center dome 1 is clearly not used as a tooth hardening portion. Instead, the sole disclosure of Sasaki's dome 1 is to house a small article to attract the interest and attention of the infant (see paragraph 0028 of Sasaki).

A fair, balanced analysis of Sasaki reveals that Sasaki's only tooth hardening portions of its device are made of a single, elastic material, which surfaces are of the same hardness.

There is no disclosure whatsoever in Sasaki, either explicit or inherent (where the case law cited above clearly holds that for something to be inherently disclosed, it cannot be just possibly disclosed, and it cannot be just probably disclosed, but must be necessarily disclosed) that its tooth hardening elements 2 have surfaces of different hardness.

Moreover, not only does Sasaki not disclose using its center dome 1 as a tooth hardening element, but the Office Action fails to explain how an infant could possibly get its teeth around the domed portion to chew on it to harden its teeth. It is obvious that an infant can grasp plate-like portions around the periphery of either Nakata or Sakata, but it is not clear how an infant can grasp the center dome 1 of Sasaki to harden its teeth, let alone grasp it between its teeth to do so.

Thus, there is no logical basis in Sasaki from which one of ordinary skill in the art can derive proper motivation to modify Nakata to provide different surfaces as having different hardnesses, especially where Nakata has no interest-generating center dome, and where neither Nakata's nor Sasaki's plate-like teeth graspable portions are disclosed as having surfaces of different hardness.

Accordingly, Applicants respectfully submit that the Office Action has made out a *prima facie* case that one of ordinary skill in the art would look to Sasaki to provide the claimed different hardness surfaces feature that both Nakata and Sasaki are missing.

Moreover, the assertion that one of ordinary skill in the art would use Sasaki's teaching of using a hard plastic dome that contains an interest generating element, e.g., a ball, flower, etc. (paragraph 0028 of Sasaki) to harden Nakata's inner annulus lacks credibility because an infant can

clearly grasp and chew on Nakata's inner annulus and Sasaki's teaching of its tooth graspable plates 2 being of a single material that obviously has a single hardness teaches away from hardening Nakata's inner annulus. Additionally, one of ordinary skill in the art would have no incentive to harden Nakata's inner annulus because it is incapable of containing an interest generating element that is clearly not usable to harden teeth.

Additionally, independent claims 6 and 18, as amended, positively recite that both the first and second tooth hardening members are adapted to be chewed by the infant. This does not occur in Sasaki, where the inner member, i.e., dome 1, is not adapted to be chewed by an infant. Obviously, an infant cannot chew on dome 1, let alone get it between its teeth to even start to chew on it, whether it tries to do so starting from the teeth hardening portion 2, or just be trying to put its head directly on dome 1 from above or below.

Applicants also note that the "adapted to" language is a positively recited structural feature of the claims. In this regard, Applicants make reference to *In re Venezia*, 189 USPQ 149 (CCPA 1976).

In that case, a number of claims were presented. Claim 31 with emphasis, was representative of the claims on appeal and read, as follows:

31. A splice connector kit having component parts *capable of being assembled* in the field at the terminus of high voltage shielded electrical cables for providing a splice connection between first and second such cables, said cables each having a conductor surrounded by an insulating jacket within a conductive shield wherein a portion of the conductive shield is removed to expose the insulating jacket and a portion of the insulating jacket is removed to expose the conductor at the terminus of the cable, the kit comprising the combination of:

a pair of sleeves of elastomeric material, each sleeve of said pair *adapted to be fitted* over the insulating jacket of one of said cables, each said sleeve having an external surface and a resiliently dilatable internal bore for gripping the insulating jacket to increase the dielectric strength of the creep path along the insulating jacket;

electrical contact means *adapted to be affixed* to the terminus of each exposed conductor for joining the conductors and making an electrical connection therebetween;

a pair of retaining members *adapted to be positioned* respectively between each of said sleeves fitted over the insulating jacket of each said cable and the corresponding terminus of each said cable, said retaining members each having means cooperatively associated therewith for maintaining each said member's position relative to the insulating jacket on each said cable and for precluding axial movement of the sleeve toward the corresponding terminus of each said cable; and

a housing, said housing having an internal bore extending therethrough from end to end, said housing including portions adjacent each end thereof defining said internal bore and being resiliently dilatable *whereby said housing may be slideably positioned* over one of said cables and *then slideably repositioned* over said sleeves, said retaining members, and said contact means *when said sleeves, said retaining members and said contact means are assembled* on said cables as hereinaforesaid, said resiliently dilatable portions of said housing respectively gripping the corresponding external surface of each said sleeve in watertight sealing relationship therewith and said housing having a further portion intermediate its ends defining said internal bore and forming a sealed chamber enclosing at least said contact means and the exposed portions of said cable conductors *when said housing is in its repositioned location*.

The Court reviewed the disputed claims and in particular the language criticized by the Examiner and the Board, and concluded that the claims do define the metes and bounds of the claimed invention with a reasonable degree of precision and particularly, and that they are, therefore, definite as required by the second paragraph of section 112. As the Court viewed these claims, they precisely define a group or "kit" of interrelated parts. The Court continued by stating:

These interrelated parts may or may not be later assembled to form a completed connector. But what may or may not happen in the future is *not* a part of the claimed invention. The claimed invention does include present structural limitations on each part, which structural limitations are defined by how the parts are to be interconnected in the final assembly, if assembled. However, this is not to say that there is anything futuristic or conditional in the "kit" of parts itself. For example, paragraph two of claim 31 calls for "a pair of sleeves * * * each sleeve of said pair *adapted to be fitted* over the insulating jacket of one of said cables." Rather than being a mere direction of activities to take place in the future, this language imparts a structural limitation to the sleeve. Each sleeve is so structured or dimensioned that it can be fitted over the insulating jacket of a cable. A similar situation exists with respect to the "adapted to be affixed" and "adapted to be positioned" limitations in the third and fourth paragraphs of the claim. The last paragraph

of claim 31 contains additional language criticized by the board, including "may be slideably positioned," "slideably repositioned," "when said sleeves * * * are assembled," and "when said housing is in its repositioned location." However, this language also defines present structures or attributes of the part of the "kit" identified as the housing, which limits the structure of the housing to those configurations which allow for the completed connector assembly desired. Again, a present structural configuration for the housing is defined in accordance with how the housing interrelates with the other structures in the completed assembly. We see nothing wrong in defining the structures of the components of the completed connector assembly in terms of the interrelationship of the components, or the attributes they must possess, in the completed assembly. More particularly, we find nothing indefinite in these claims. One skilled in the art would have no difficulty determining whether or not a particular collection of components infringed the collection of interrelated components defined by these claims. In re Miller, *supra*.

Applicants respectfully submit that claims 6 and 18, by reciting "wherein . . . both the first and second tooth-hardening members are adapted to be chewed by the infant," are positively reciting present structures or attributes of the identified first and second tooth-hardening members, which limits the structure of those members.

Accordingly, Applicants respectfully submit that the Office Action does not make out a *prima facie* case of obviousness of the claimed invention based on these applied references.

Reconsideration and withdrawal of this rejection of claims 6, 10 and 18 are respectfully requested.

Claims 7 and 8 stand rejected under 35 USC §103(a) as being unpatentable over Nakata in view of Sasaki and further in view of U.S. Patent 2,532,116 to Monaco. This rejection is respectfully traversed.

Claim 7 positively recites that the first hardening member has a space formed substantially in a center portion of the first tooth-hardening member, the space being contained within two transparent covers which abut one another.

None of the applied reference contains such a positively recited combination of features. So, no matter how these references are combined, they cannot result in, or otherwise render obvious, the claimed invention.

Additionally, because Monaco is not applied to remedy the aforementioned deficiencies in the Nakata-Sasaki reference combination, even if, for sake of argument only, one of ordinary skill in the art were properly motivated to modify the Nakata-Suchowski reference combination in view of Monaco, as suggested, the resulting modified version of Nakata would not meet or otherwise render obvious, the claimed invention.

Accordingly, Applicants respectfully submit that the Office Action does not make out a *prima facie* case of obviousness of the claimed invention based on these applied references.

Reconsideration and withdrawal of this rejection of claims 7 and 8 are respectfully requested.

Claim 9 stands rejected under 35 USC §103(a) as being unpatentable over Nakata in view of Sasaki and U.S. Patent 2,532,116 to Monaco, and further in view of U.S. Patent 1,117,093 to Ripley. This rejection is respectfully traversed.

Initially, the Nakata-Sasaki-Monaco reference combination does not disclose or suggest, or otherwise render obvious claim 7, from which claim 9 depends, for reasons discussed above. Moreover, Ripley is not applied in this rejection to remedy the aforementioned deficiencies of the Nakata-Suchowski-Monaco reference combination with respect to claim 7. So even if, solely for sake of argument, that one of ordinary skill in the art were properly motivated to modify the Nakata-

Suchowski-Monaco reference combination in view of Ripley, as suggested, the resulting modification of Nakata would still not be met, suggested, or otherwise rendered obvious.

Furthermore, Ripley does not disclose the abutment feature of the transparent covers, which is an additional reason why this reference combination does not render obvious the claimed invention.

Accordingly, Applicants respectfully submit that the Office Action does not make out a *prima facie* case of obviousness of the claimed invention based on these applied references.

Reconsideration and withdrawal of this rejection of claim 9 are respectfully requested.

Conclusion

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot, and Applicants have clearly pointed out why the finality of the outstanding Office Action should be withdrawn, claim 17 examined on its merits in the next Office Action, and the current Amendment be entered as a matter of right.. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding rejections and that they be withdrawn, and that a new Office Action be prepared and mailed which additionally examines claims 17 and 18 on their merits. It is believed that a full and complete response has been made to the outstanding Office Action. Applicants also respectfully submit that the present application is in condition for allowance.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone Paul C. Lewis, Registration No. 43,368, at (703) 205-8000, in the Washington, D.C. area.

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Prompt and favorable consideration of this Amendment is respectfully requested.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

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Respectfully submitted,

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Attachment: JPO Computer Translation of Sasaki (JP 06-339-514 (7 pages))

PCL/RJW/jmc

